III.   REMARKS

1.   Claims 1-4, 7-11, 15, 17, 35, 36, 38-40, 42-44, 47-51, and 53-61 remain in the application. Claims 5, 6, 12-14, 16, 18-34, 37, 41, 45, 26, and 52 have been cancelled without prejudice. Claims 1, 11, 35, 39, 43, 48, 50, 51, and 55 have been amended to correct typographical errors.

The amendments to the claims do not raise issues of estoppel.

2.   Applicant respectfully submits that claims 1-4, 7-11, 15, 17, 35, 36, 38-40, 42-44, 47-51, and 53-61 are patentably distinct from claims 1-13 of US Patent No. 6,678,361 (the '361 patent) and that no terminal disclaimer is required.

Claim 1 of the present application reads:

> 1. A method comprising:
>
> > receiving and storing a multimedia message;
> >
> > retrieving information about properties of a wireless terminal from a user profile for the wireless terminal stored in the server;
> >
> > identifying by said server at least one component of the multimedia message which the wireless terminal can handle according to the retrieved properties of the wireless terminal; and
> >
> > transmitting the at least one component to the wireless terminal.

Claim 4 of the present application reads:

> 4. The method according to claim 1, further comprising:
>
> > transmitting a notification message to the wireless terminal comprising information about at least one property of said at least one multimedia component.

Claim 8 of the present application reads:

8. The method according to claim 1, wherein said information on the properties of the wireless terminal comprises information on the capability of the wireless terminal to process multimedia components of a particular type.

In contrast, claim 7 of '361 reads:

7. A method for delivering messages in a communication network consisting of at least one terminal and a multimedia messaging service center, said method comprising the steps of

receiving a message (MM) for said terminal (MS) by said multimedia messaging service center (MMSC);

sending a notification (MMSNotify) that notifies about the presence of said message (MM) from said multimedia messaging service center (MMSC) to said terminal (MS), the notification containing information describing the properties of the message;

deciding by said terminal (MS) based on its capabilities (CAP), current user profile (UP) and the properties of the message provided by the notification how said message (MM) should be handled;

replying by said terminal (MS) to the notification sent by said multimedia messaging service center (MMSC), therewith instructing said multimedia messaging service center according to the result of said decision step; and

handling said message (MM) by said multimedia messaging service center (MMSC) according to said instructions.

Claim 1 of the present application states that the server identifies which component the wireless terminal can handle. Furthermore, the decision is based on the user profile stored in the server. In claim 7 of '361, the decision on how to handle the message is made by the terminal which instructs the multimedia messaging service center according to the result of the decision. Still further, the user profile (UP) is located in the terminal.

Therefore, although claim 4 of the present application defines transmitting a notification message containing information about the property of the multimedia component, the subject

matter of the combination of claims 1 and 4 are different from the claims of the '361 patent. They differ at least in which element makes the decision on how the message should be handled. In addition, the location of the user profile is different.

At least for these reasons, the claims of the present application are patentably distinct from claims 1-13 of the '361 patent.

3.   Applicants respectfully submit that claims 1-4, 7-11, 15, 17, 35, 36, 38-40, 42-44, 47-51, and 53-61 are patentable over the combination of Bull et al. (US 5,901,287, "Bull") and Theimer et al. (US 5,544,321, "Theimer") under 35 USC 103(a).

Bull discloses an information aggregation and synthesization system and process. The system provides aggregation and packaging of structured or unstructured information from disparate sources such as those available on a network such as the Internet. A network compatible/addressable interface device is operated by a user. The network interface device communicates with local datastores or network accessible datastores via an addressing scheme such as Uniform Resource Locator addresses (URLs) utilized by the Internet. Data passing between the network interface device and the datastores is accessed, polled, and retrieved through an intermediary gateway system. Such aggregated information is then synthesized, customized, personalized and localized to meet the information resource requests specified by the user via the network interface device (see the Abstract).

According to the col. 3, lines 26-42, the user initiates access to the system through a network addressable interface device (such as a personal computer, Internet Appliance, an interactive television or even a personal digital assistant or smart telephone). The user is then connected to the information aggregation and synthesization system via a network service provider (most likely through the Internet or some variation). The user logs on to the system either by name, address, etc. or with some pseudonym (or some combination). This allows the user's activity to be tracked and establishes a log of the user's activity during the current online experience (session). The user is also asked for explicit profile information concerning preferences. These preferences will be used to narrow the information retrieval and may be collected when the user first logs in or incrementally as the user asks for specific information. This profile information will be kept and updated as the individual user's preferences change.

The user profile contains information relating to the user e.g. key words used by the user when performing searches in the system. See, for example, col. 4, lines 28-33:

> *"During a user session or when a user completes a session, the user's looking activity is analyzed for patterns, preferences and trends and the profile annotated or updated so that when they next use the information aggregation and synthesization system, the nominated searches will be customized to their individual desires."*

Section IV. Automated Profile Generation in column 13, line 59 through column 14, line 9,-also reveals that the user profile contains information related to the user's preferences, not to the properties of the wireless terminal.

Further, section 210 User Profile DataStore in column 10, lines 34-38 discloses:

> *This [User Profile DataStore] contains data about the user, preferences, situational preferences, accounting information, psychographic profile, personal profile and other relevant information related to the user by individual identifier.*

Column 4, lines 7-15 disclose that the <u>user</u> selects information to be viewed from the results of the search. This information is retrieved from its source and presented to the user in the manner and at the time requested. There is no indication whatsoever in Bull that the user profile could contain information about properties of the wireless terminal. Moreover, Bull does not disclose receiving and storing multimedia <u>messages</u>, and identifying by said server at least one component of the multimedia message which the wireless terminal can handle according to the retrieved properties of the wireless terminal.

The passage from column 6, line 59 through column 7, line 12 disclose the initial setup for advertisers.

> *Advertisers, using a user access system 100 enter criteria that should met for an advertisement/coupon placement. These criteria are in the form of the complex software text search agents described above. This includes a match "threshold". When this threshold is met or exceeded, an ad/coupon will be appended to a system session. Statistical analysis known as clustering is used to evaluate the data.*
>
> *The ad/coupon may be resident on the user access system 100, an advertiser's computer system (400 . . . N) or stored in the Advertising DataStore 250. Additionally, the Advertiser may include conditional criteria for ad/coupon placement (available inventory, in stock levels, excess capacity, etc.). This criteria is referenced when the "threshold" is met and if satisfactory, the ad/coupon is appended. This criteria may be tested against data input through*

the user access system 100, data on the advertising datastore 250 or data on the advertiser's computer system (400 . . . N). Additionally, advertisers can input World Wide Web (WWW) referential information (hot links) to be displayed with ads/coupons or on geographic map displays. These are stored on the advertising datastore 250."

The ad/coupon is not a multimedia message but a piece of information pushed to the user access system when a conditional criteria is met. The criteria mentioned by Bull et al include available inventory, in stock levels, excess capacity. It is clear that the excess capacity can not relate to the properties of the user access system but to the production capacity of the advertiser's manufacturing site (all the other used criteria relate to products in stocks). The applicant is of the opinion that in this context it is not justified to assume that the term *excess capacity* could relate to the properties of the user access system.

Theimer describes a method for superimposing prespecified locational, environmental, and contextual controls on user interactions, including interactions of mobile users, with computational resources. A system is described for electronically monitoring contextual information concerning users and machines, including state and locational information including proximity. Interaction policies, including user specified interaction policies, may be registered on an identifiable address path. Methods are described for detecting, selecting and controlling computer controlled devices, based on the proximity of the device to the user, the current context of the user, the location of other nearby users and devices, and the current state of the devices. Temporary transfer of control, including exclusive control, of particular computers and computer controlled devices to individual users based on the context and environment in proximity to those computing devices is also described (see the Abstract).

The Examiner refers to column 27, lines 15-26 to show that Theimer teaches that *the user may specify customization the properties for the device.* In this paragraph, Theimer discloses that the user profile may specify preferred customization properties for the device. For example, the user may desire a mail window to be retrieved automatically and displayed upon login to a device, such as a Pad, or an entire electronic desktop be retrieved for display on a workstation. This kind of information is merely indicating the desires of the user. It is not indicating the actual properties of the device. For example, one user may define that a mail window is to be retrieved automatically but another user using the same device might define that no mail window will to be retrieved automatically. Therefore, the user profile can provide different, even contradictory information relating to the same device. Therefore, the combination of Bull and Theimer does
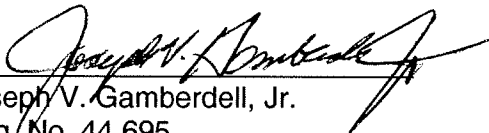
not disclose each and every feature of independent claims 1, 35, and 43. Dependent claims 2-4, 7-11, 15, 17, 36, 38-40, 42, 44, 47-51, and 53-61 are patentable because of their dependencies.

At least for these reasons, the combination of Bull and Theimer fails to render claims 1-4, 7-11, 15, 17, 35, 36, 38-40, 42-44, 47-51, and 53-61 unpatentable.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

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Date 27 January 2009

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